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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants: Daniel K. SCHIFFER
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Serial No.: 10/036,106

Group No.: 1771

Filing Date: 09 November 2001

Examiner: Peter Y. Choi

Title: BIODEGRADABLE BREATHABLE
FILM AND LAMINATE

Customer No.: 35844

REPLY BRIEF UNDER 37 C.F.R. §41.41

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. §41.41, Applicants respectfully submit this reply brief. The reply brief responds to the Examiner's Answer dated 31 August 2007.

A. The Obviousness Rejections Based On Gallagher In View Of Moss Are Not Supported By Fact Or Law

The Examiner maintains the rejection of Claims 21-26, 31, 35, 38-40, 48, 49, 53, 54 and 56-58 under 35 U.S.C. §103(a) based on Gallagher (U.S. Patent 5,171,308) in view of Moss (U.S. Patent 4,698,372) for three reasons. First, the Examiner argues that the portion of Gallagher that Applicants rely on (namely, Col. 2, lines 34-40) is a description of related art, and the Examiner is not relying on that portion.

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Marshall A. Peltan

Signature

However, the Examiner is required to consider the prior art as a whole. See MPEP §2141, citing *Hodosh v. Block Drug Co. Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n. 5 (Fed. Cir. 1986). Thus, it is improper for the Examiner to ignore the cited portion of Gallagher, which plainly teaches away from using polycaprolactones and other listed polymers, merely by stating that the Examiner does not rely on the negative teaching.

Second, the Examiner argues that Gallagher teaches a biodegradable thermoplastic polymer at Col. 1, line 45 – Col. 2, line 1. This point is not disputed. However, the polymers taught by Gallagher do not anticipate or render obvious the specific polymers recited in Applicants' Claims 21 and 54.

Third, the Examiner argues that Gallagher teaches adding polycaprolactone to the polyesters which define the invention of Gallagher, at Col. 7, lines 39-50. However, that passage states that polycaprolactone may be present in the prepolymerization reaction mixture along with other reaction components. Gallagher does not disclose or suggest polycaprolactone as a reaction product, resulting from the polymerization reaction. Instead, the reaction product is described as a polyester “in which the units are randomly distributed along the molecular chain” (Col. 7, lines 39-44). As explained above, Gallagher plainly teaches away from polycaprolactone polymers, and distinguishes them from the inventive polyesters (Col. 2, lines 34-40).

Also, the Examiner apparently does not dispute that Gallagher fails to disclose a breathable outer cover laminate of a film and a nonwoven web, in which every film layer and the nonwoven web includes the biodegradable thermoplastic polymer as recited in Applicants' Claims 21 and 53. For instance, the nonwoven web in Gallagher is made of cotton, rayon or paper (Col. 11, lines 42-48). The Examiner states that Gallagher discloses “disposable” products, but incorrectly equates the term “disposable” with “biodegradable.” The term “disposable” generally refers to products that are discarded after a single use or a few uses, instead of being washed and re-used. Numerous products which are disposable (e.g. polyolefin films, aluminum foils, plastic containers and the like) are not biodegradable. Moss also does not disclose such a breathable outer cover laminate. As previously explained, Moss is directed to a single-layer film.

The Examiner also maintains the rejection of Claims 53 and 56-58 under 35 U.S.C. §103(a) as obvious over Gallagher in view of Moss. The Examiner does not rebut Applicants' argument that Gallagher fails to teach a nonwoven web formed of a

biodegradable thermoplastic polymer. Instead, the nonwoven web of Gallagher is formed of cotton, rayon or paper. Thus, Gallagher does not disclose the claimed laminate in which every layer (including the fibrous nonwoven web) is formed of a biodegradable thermoplastic polymer. Moss discloses only a single-layer film, and does not disclose the claimed laminate in which every layer (including the fibrous nonwoven web) includes the biodegradable thermoplastic polymer.

Again, the Examiner improperly interprets the disclosure of “disposable” articles in Gallagher as meaning that every layer is biodegradable. While biodegradable materials are typically disposable, the converse is not always true. Any article which can be disposed of after a single use is disposable.

Accordingly, the obviousness rejections based on Gallagher in view of Moss should be reversed.

B. The Obviousness Rejections Based On Gallagher In View Of Moss And McCormack Are Not Supported By Fact Or Law

The Examiner maintained the rejections of Claims 41 and 44-47 under 35 U.S.C. §103(a) as obvious over Gallagher in view of Moss and McCormack (U.S. Patent 5,955,187). These claims depend from Claim 21, and are patentable for at least the same reasons, explained above. Additionally, McCormack plainly does not disclose a breathable outer cover laminate in which every film layer and the nonwoven web layer includes the claimed biodegradable thermoplastic polymer. Accordingly, McCormack does not fill in the disclosure that is missing from Gallagher combined with Moss.

The Examiner maintains the rejection of Claims 50-52 under 35 U.S.C. §103(a) as obvious over Gallagher in view of Moss and McCormack. For the reasons previously explained, the combination of references does not disclose a breathable outer cover laminate in which every film layer and the nonwoven web layer includes the biodegradable thermoplastic polymer (as recited in Claims 21 and 50). For instance, none of the references discloses a nonwoven web formed of the claimed biodegradable thermoplastic polymer. The Examiner fails to address this point.

Independent Claim 50 also requires at least two adjacent film layers including about 5-80% by weight filler particles and about 20-95% by weight biodegradable thermoplastic polymer, having voids around the filler particles. The Examiner did not address this claim limitation. The disclosure of Moss is limited to a

single-layer film. The disclosure of Gallagher mentions a film, but does not provide details of a film structure (Col. 11, lines 41-46). Notably, the topsheet film mentioned in Gallagher would typically not contain a filler because topsheets are intended to be highly liquid permeable. Such topsheet films are typically apertured. The technology of stretching filled films to form voids around filler particles is typically used for films that are intended to be liquid-impermeable yet breathable to water vapor.

Accordingly, the obviousness rejections based on Gallagher in view of Moss and McCormack should be reversed.

C. The Obviousness Rejections Based On Gallagher In View Of Moss And Trinh Or Borgher Or Chandler Are Not Supported By Fact Or Law

The Examiner maintained the rejection of Claims 42 and 43 under 35 U.S.C. §103(a) as obvious over Gallagher in view of Moss and either of Trinh (U.S. Patent 5,968,404) or Borgher (U.S. Patent 5,139,687). These claims depend from Claim 21 and are patentable for at least the same reasons, explained above. The combination of references does not disclose a breathable outer cover laminate in which every film layer and the nonwoven web layer includes the biodegradable thermoplastic polymer as claimed. Trinh and Borgher do not fill the gaps in the disclosures of Gallagher and Moss.

Furthermore, the Examiner is incorrect in stating that Claims 42 and 43 do not require the cyclodextrin filler to be within a biodegradable thermoplastic polymer film layer. This requirement is apparent from the language of independent Claim 21. Application of the cyclodextrin as a spray or powder as disclosed in Trinh and Borgher would not satisfy this requirement, and would not result in the claimed void formation around the filler particles.

The Examiner maintained the rejection of Claim 37 under 35 U.S.C. §103(a) as obvious over Gallagher in view of Moss and Chandler (U.S. Patent 6,028,160). Claim 37 depends from Claim 21 and is patentable for at least the same reasons, explained above. The combination of references does not disclose a breathable outer cover laminate in which every film layer and the nonwoven web layer includes the biodegradable thermoplastic polymer as claimed. Chandler does not fill in the gaps in the disclosures of Gallagher and Moss.

Accordingly, the obviousness rejections based on Gallagher and Moss combined with Trinh, Borgher or Chandler should be reversed.

D. Conclusion

Applicants respectfully request reversal of the rejection of all pending claims based on 35 U.S.C. §103(a).

Respectfully submitted,



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